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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/844,322	04/26/2001	Casey William Norman	1391-CON-00	1969

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EXAMINER

FRANCIS, FAYE

ART UNIT PAPER NUMBER

3712

DATE MAILED: 09/07/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/844,322

Applicant(s)

NORMAN ET AL.

Examiner

Faye Francis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-23,25,26 and 28-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-23,25,26 and 28-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP j 608.01(0). Correction of the following is required: proper antecedent basis should be provided in the specification for the teaching of the doll's garment having a molded shape to fit over, in a life-like way external surfaces of at least a portion of a doll that has articulated limbs as recited in claims 21-22. Additionally, proper antecedent basis should be provided in the specification for the teaching of the average modulus of elasticity is less than 1 MN/M2 as recited in claims 22, 30 and 47, the 100% modulus of elasticity is between 240 and 280 KN/M2 as recited in claims 31, 42 and 51 . Also, proper antecedent basis should be provided in the specification for the teaching of the 300% modulus of elasticity is between 440 and 490 KN/M2 as recited in claims 32 and 43 and 100% modulus of elasticity is between 120 and 350 KN/M2 as recited in claim 50. No new matter should be entered into the application.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 1 12:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 31-32, 41-43 and 50-51 are rejected under 35 U.S.C. 1 12, first paragraph, as failing to comply with the enablement requirement. The claim (s) contains subject matter, which was not described in the specification in such a way as to enable

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one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. It is not clear from the specification what the applicant refers as 100% or 300% modulus of elasticity.

3. Claims 21-22, 30-32, 34, 41-43, 47 and 50-51 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor (s), at the time the application was filed, had possession of the claimed invention, i.e., New Matter.

The specification as originally filed does not provide support for the limitations "the doll's garment having a molded shape to fit over, in a life-like way external surfaces of at least a portion of a doll that has articulated limbs as recited in claims 21-22" as recited in claims 21-22, "the average modulus of elasticity is less than 1 MN/M²" as recited in claims 22, 30 and 47, "the 100% modulus of elasticity is between 240 and 280 KN/M" recited in claims 31 42 and 51, "the 100% modulus of elasticity is between 120 and 350 KN/M" recited in claims 41 and 50 and the doll is articulated at a joint selected from the group consisting of the neck as recited in claim 34.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

5. Claims 21, 38 and 47 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 21, 38 and 47: the phrase "in a life-like way/manner" is confusing, since the structural limitations added to the claims by this phrase cannot be determined.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 21-23, 25-26, 28, 30-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kramer in view of O'Brian et al, hereinafter O'Brian and either Gross or Wion.

Kramer discloses most of the elements of these claims including a doll, a doll's garment (col 1 lines 51-57) formed from a flexible sheet of polymer plastic material between 2mm and 6 mm in thickness and with modulus of elasticity of less than 750 pound per square inch (less than 1 MN/M) and the doll's garment has a shape to fit over the external surfaces of at least a portion of the doll.

Kramer does not disclose an elastic injection molded thermoplastic elastomer doll's garment and doll having articulated limbs as recited in claim 21 and 22, a finish selected from the group consisting of paint, varnish, and glitter as recited in claim 26, the garment is less than 8 cm in height as recited in claim 28 and a play set comprising a doll wherein the doll is articulated at a joint selected from the group consisting of the shoulders, elbows, knees, neck, and hips as recited in claim 34.

O'Brian in at least in some of the embodiment such as Figs 2 and 3 teaches the concept of providing an elastic injection molded thermoplastic elastomer [col 4 line 58 and also [[**re-sil-ient** (rî-zîl'yent) *adjective* 1. Capable of returning to an original shape or position, as after having been compressed.] according to Merrian-Webster's Collegiate Dictionary Tenth Edition] and (col 3 lines 54-56)] doll's garment. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the teaching of the injection molded thermoplastic elastomer of O'Brian with the doll's garment of Kramer for aesthetic reasons and to provide more flexibility.

Either Gross or Wion teaches that it is conventional to have articulated shoulders, elbows, knees, neck, and hips in a play set comprising a doll and a doll's garment or in a planar doll [two dimensional]. It would have been obvious to further provide the modified device of Kramer with the articulated doll as disclosed by either Gross or Wion, for the purpose of making the device more enjoyable for the children to play with.

With respect to claim 26: it is generally well known to decorate garment with glitter or paint. Therefore, it would have been obvious to further modify the Kramer's device to have glitter or paint for aesthetic reasons or as a matter of obvious design choice.

With respect to claim 28, it would have been obvious to further provide the garment of Kramer in the claimed height for the purpose of making the devices easier to play with and to accommodate for small dolls.

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8. Claims 20, 29 and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kramer in view of O'Brian and either Gross or Wion as applied to claims 21-23, 25-28,30-34 and further in view of Yasuda.

Modified device of Kramer has most of the elements of these claims but for the specific thermoplastic elastomer material.

Yasuda discloses using the thermoplastic elastomer containing styrene (col 3 lines 18-54) in order to make clothes for dolls as the constituent element of dolls). It would have been obvious to make the modified device of Kramer out of thermoplastic Elastomer-containing styrene as taught by Yasuda in order to give the device more flexibility.

9. Claims 38-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kramer in view of O'Brian, Yasuda and either Gross or Wion.

Kramer discloses most of the elements of these claims including a doll, a doll's garment (col 1 lines 51-57) formed from a flexible sheet of polymer plastic material between 2mm and 6 mm in thickness and with modulus of elasticity of less than 750 pound per square inch (less than 1 MN/M2).

Kramer does not disclose an injection molded thermoplastic elastomer doll's garment, the specific thermoplastic elastomer material, a play set comprising a doll and a doll's garments wherein doll is articulated at elbows and knees as recited in claims 38 and 47. Additionally, Kramer does not disclose a finish selected from the group consisting of paint, varnish, and glitter as recited in claim 46.

O'Brian in at least some of the embodiment such as Figs 2 and 3 teaches the concept of providing injection molded thermoplastic elastomer (col 3 lines 54-56) doll's garment. It would have been obvious to use the teaching of the injection molded thermoplastic elastomer of O'Brian with the doll's garment of Kramer for aesthetic reasons and to provide more flexibility.

Yasuda discloses using the thermoplastic elastomer containing styrene (col 3 lines 18-54) in order to make clothes for dolls (as the constituent element of dolls). It would have been obvious to further make the device of Kramer out of thermoplastic Elastomer-containing styrene as taught by Yasuda in order to give the device more flexibility.

With respect to claim 46: it is generally well known to decorate garment with glitter or paint. Therefore, it would have been obvious to further modify the Kramer's device to have glitter or paint for aesthetic reasons or as a matter of obvious design choice.

Either Gross or Wion teaches that it is conventional to have articulated shoulders, elbows, knees, neck, and hips in a play set comprising a doll and a doll's garment or in a planar doll [two dimensional]. It would have been obvious to further provide the modified device of Kramer with the articulated doll as disclosed by either Gross or Wion, for the purpose of making the device more enjoyable for the children to play with.

Response to Arguments

10. Applicant's arguments filed 7/22/04 have been fully considered but they are not persuasive.

In response to applicant's argument in page 8 that teaching of the average modulus of elasticity are found at varying location, the examiner would like to point out as stated in the last office action that all the references in the specification in regard to different modulus of elasticity are directed to the MN/M (**negative 2**) and not to MN/M2 [please refer to the specification as filed]. Additionally, in response to applicant's argument that disclosure concerning the doll being articulated at the neck is readily seen in Figs. 2d and e and page 2, line 27, respectively. The examiner would like to point out that neither the disclosure nor the Figs. 2d and e give support for the limitation as claimed [looking at the Figs. 2d and e, one can not come to the conclusion that the neck of the doll is articulated as claimed [the neck appears to be integral with the torso]].

Turning now to the applicant's argument on the bottom of page 9, the examiner note with appreciation the applicant's helpful comments concerning the clarification as to what is meant by 100% or 300% modulus of elasticity. However, the argued structure which stretches the object 3 times its original state is not set forth in the claim nor the specification and thus do not provide a basis for patentable distinction because of the reasons already noted the rejection stands.

In response to applicant's argument in page 9 that support for the thermoplastic elastomer being "colorless" may be found on page 5 at line 20, the examiner

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would like to point out that the page 5 cannot be found in the papers filed [the disclosure as originally filed only contains 4 pages] and because of the reasons already noted the rejection stands.

In response to applicant's argument in page 10 second full paragraph that of O'Brian is not applicable because it does not anywhere mention the words "injection" or "elastomer". O'Brian at the least teaches a single piece of resilient thermoplastic material such as polyethylene, polystyrene or the like but does not specifically teach an elastomer. However, the material that expressly taught in O'Brian reference would encompass various types of elastomer, which are well known resilient material [col 4 line 58]. Surely the applicant is not suggesting that he is the first to recognize that elastomer is a resilient material. Additionally, injection molding is a well-known process and since the reference teaches molding it may include any known type of molding including injection molding.

In response to applicant's argument in page 11 second full paragraph Kramer is directed to clothing items that are essentially two dimensional, i.e. planar, while O'Brian is directed to "snap-on" clothing items, the examiner would like to point out that Kramer reference was only applied to show a doll's garment formed from a flexible sheet of polymer plastic material between 2 mm and 6 mm in thickness and with modulus of elasticity of less than 1 MN/M². The fact that the Kramer is directed to clothing items that are essentially two dimensional while O'Brian is directed to "snap-on" clothing items are irrelevant.

In response to applicant's argument in page 9 last paragraph that one of ordinary

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skill in the art would have utterly no incentive or motivation to combine O'Brian with Kramer. The examiner recognizes that references cannot be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re Simon, 174 USPQ 1 14 (CCPA 1972)., In re McLaughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA 1969).

The question under 35 USC j103 is not merely what the references expressly teach but what they would have suggested to one of ordinary skill in the art at the time the invention was made. See *Merck & Co., Inc. v. Biocraft Laboratories, Inc.*, 874 F.2d 804, 10 USPQ2d 1843 (Fed. Cir. 1989) and *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). While there must be some suggestion or motivation for one of ordinary skill in the art to combine the teachings of references, it is not necessary that such be found within the four corners of the references themselves', a conclusion of obviousness may be made from common knowledge and common sense of the person of ordinary skill in the art without any specific hint or suggestion in a particular reference. See *In re Bozek*, 416 F.2d 1385, 163 USPQ 545 (CCPA 1969). j

As long as some motivation or suggestion to combine the references is provided by the prior art taken as a whole, the law does not require that the references be

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combined for the reasons contemplated by the inventor. In re Beattie, 974 F.2d 1309, 24 USPQ2d 1040 (Fed. Cir. 1992)', In re Dillon, 919 F.2d 688, 16 USPQ2d 1897, 1905 (Fed. Cir. 1990)., In re Kronig, 539 F.2d1300, 190 USPQ 425 (CCPA 1976)', In re Wilder, 429 F.2d 447, 166 USPQ 545 (CCPA 1970).

In this case, the artisan would have been motivated to use the teaching of the injection molded thermoplastic elastomer of O'Brian with the doll's garment of Kramer for aesthetic reasons and to provide more flexibility. Also, to further modify the Kramer's device to have glitter or paint for aesthetic reasons or as a matter of obvious design choice. Additionally, it would have been obvious to further provide the garment of Kramer in the claimed height for the purpose of making the devices easier to play with and to accommodate for small dolls.

Thus, taking into account all of the knowledge in the art as previously discussed, the real reason for the applicant's claims of non obviousness may simply be that Kramer does not identically disclose all of the elements of the claims as amended after the first Office Action. Such reasoning is clearly improper.

In response to applicant's argument on pages 13 regarding that Yasuda refers to injection molded resin layers which are laminated with other films to form a resulting resin molded article when the Applicants' garments are actually injection molded thermoplastic elastomer and that one of ordinary skill in the art would have no comprehension as to whether the laminate (not the layers) is elastic as claimed. Examiner disagrees, since the applicant claims that the garment made out of specific thermoplastic elastomer are in fact elastic and since the Yasuda refers discloses the

layers which together forms the laminated layer that is made out of the same material as claimed, the layers forming the laminate are elastic.

In response to applicant's argument in page 12, that applicant's injection molded thermoplastic elastomer garments are seamless, which is inherently not the case in Yasuda by virtue of the fact that the Yasuda figures which illustrate the inherently resulting seams associated with laminating multiple layers together. The examiner would like to point out the nothing in the specification taught that the word "seamless" encompassed no laminated as already noted and shown by applicant's remark. Furthermore, since the word "seamless" was not in the original disclosure as filed and it is not going to be allowed in (New Matter).

In response to characterization or style, applicant may styled the rejections as hypothetical. However, the examiner has made a prima facie case which applicants have not overcome therefore the claims are not allowed.

In response to applicant's argument in page 14 that the bladder portions of Gross do not extend over the articulable areas, the examiner would like to point out that applicant never claims that something must extend over the articulated ares. Prior art applied by the examiner in a rejection of claims is not required to show that which is not claimed.

In response to applicant's argument in page 14 that although Gross discloses a doll with articulated limbs, the bladder portions of Gross do not extend over the articulable areas and the bladders are restricted to particular areas that do not include articulated portions, the examiner would like to point out that Gross reference was only

applied to show that it is conventional to have articulated shoulders, elbows, knees, neck, and hips in a play set comprising a doll and a doll's garment. The fact that the Gross's bladder portions do not extend over the articulable areas and the bladders are restricted to particular areas that do not include articulated portions are irrelevant.

In response to applicant's argument in page 15 that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

In response to characterization or style, applicant may styled the rejections as hypothetical. However, the examiner has made a prima facie case which applicants have not overcome therefore the claims are not allowed.

Conclusion

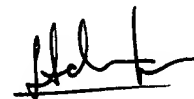
11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Faye Francis whose telephone number is 703-306-5941. The examiner can normally be reached on M-F 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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FF



Jacob K. Ackun
Primary Examiner